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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,929	02/19/2002	Sabina Sperandio	066817-0012	6504

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EXAMINER

GAMETT, DANIEL C

ART UNIT	PAPER NUMBER
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1647

MAIL DATE	DELIVERY MODE
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08/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/079,929

Applicant(s)

SPERANDIO ET AL.

Examiner

Daniel C. Gamett, PhD

Art Unit

1647

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 19 July 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 4-6 and 11-16.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/David Romeo/
Primary Examiner
Art Unit 1647

Continuation of 11. does NOT place the application in condition for allowance because: Claims 4-6 and 11-16 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, for reasons of record. Applicant's arguments filed 07/19/2007 have been fully considered but they are not persuasive. Each of Applicant's arguments has been addressed in the record. Applicant is referred to especially to section 3e of the Office Action mailed 09/06/2005, which addresses the question of undue experimentation.

Rejections of Claims 4-6 and 11-16 under 35 U.S.C. 102(e) as being anticipated by Bennett et al., publication number 20040072888, and of claims 4 and 5 under 35 U.S.C. 102(a) as being anticipated by Bennett et al, Proc. Nat. Acad. Sci. (USA) vol.98, no.24, Nov. 20, 2001 are maintained. Applicant's joint arguments against these rejections have been fully considered but they are not persuasive. With regard to application 20040072888, the Examiner has made the determination that the parent application provides the teachings necessary for support the use of the filing date of this document as the priority date under 102(e). Since SP600125 was already known to inhibit JNK and inhibit programmed cell death, Applicant's discovery represents an elucidation of a mechanism but does not, however, make SP600125 into a new compound and it does not make the use of SP600125 to prevent cell death or treat conditions associated with programmed cell death a novel method. The ability to inhibit JNK is necessarily present in SP600125 and therefore SP600125 inherently inhibits JNK-dependent pathways including apoptosis, paraptosis, or any other process that may subsequently be found to require JNK activity.

Claims 6 and 11-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al, Proc. Nat. Acad. Sci. (USA) vol.98, no.24, Nov. 20, 2001 as applied to claims 4 and 5, and in further view of Braun et al., Expert Opin Investig Drugs. 1999 Oct;8(10):1599-1610). Applicant's argument is based on the alleged deficiency of the primary reference, which is refuted above. Irrespective of any mechanism of action, it would have been obvious to one of skill in the art at the time the invention was made to use SP600125, as taught by Bennett et al., in a combination therapy as taught by Braun et al. with a reasonable expectation of success and with the motivation of achieving maximum protection from programmed cell death.